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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,956	03/11/2004	Larry E. Wittmeyer JR.	000409-0167	4878
27910 7590 01/03/2007 STINSON MORRISON HECKER LLP ATTN: PATENT GROUP 1201 WALNUT STREET, SUITE 2800 KANSAS CITY, MO 64106-2150			EXAMINER AHMAD, NASSER	
			ART UNIT 1772	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			01/03/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/797,956

Applicant(s)

WITTMAYER, LARRY E.

Examiner

Nasser Ahmad

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-70 is/are pending in the application.
- 4a) Of the above claim(s) 1-44 and 54-62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 45-53 and 63-70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Rejections Maintained***

1. Claims 45-47, 68 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaye (5390819) for reasons of record made in the last Office Action of 4/13/2006.
2. Claims 48-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaye in view of James (2415012) for reasons of record made in the last Office Action of 4/13/2006..
3. Claims 63-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaye for reasons of record made in the last Office Action of 4/13/2006..

### ***Response to Arguments***

4. Applicant's arguments filed 10/16/2006 have been fully considered but they are not persuasive.

Applicant argues that *there is absolutely no suggestion or teaching of any type that the stack of flexible sheets disclosed in the Kaye Patent could be utilized as a toy. To the contrary, the stack of flexible sheets disclosed in Kaye is used solely in combination with a dispenser that houses the sheets in a compact flat configuration. See, Kaye Patent, Col. 4, lines 31-36 ("since the ultimate object is to improve the ability of the separated sheets to lie flat during use, the corner placement of the adhesive in the sheets of the invention is superior to the edge band placement of the adhesive in the sheets of the prior art shown in FIG. 6.")*. As such, it is not possible to use the stack of flexible sheets as a toy, nor is there any suggestion that this stack of sheets could be

Art Unit: 1772

*utilized as a toy. Notwithstanding this fact, the Examiner baldly asserts that it would be obvious to use the stack of flexible sheets shown in Kaye as a recreational toy. The Examiner does not provide any evidence to support that conclusion, but instead relies upon a subjective hindsight analysis.* These are not deemed to be convincing because, in response to applicant's argument regarding **hindsight**, it must be recognized that any judgement on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. So long as it takes into account only knowledge which was within the level of ordinary at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. In re McLaughlin, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971). In this case, Kaye clearly teaches the structured stack of flexible sheet as claimed. As for allegation of bald assertion by the examiner, applicant is directed to the last Office Action, paragraph-6, wherein it has been explained in detail as to why it would have been obvious to use the stack as a recreational toy because said stack, when expanded into the form as shown in figures 4 and 6, as it will provide for recreation to the user.

As for the stack of Kaye being solely used with a dispenser, applicant is informed that figure-5 shows the alleged stack with a dispenser, while figure-2 shows the stack by itself. In the alternative, applicant has failed to show that the stack of sheets cannot be used by itself.

Applicant further argues that *the record establishes that FIGs. 4 and 6 are for purposes of illustrating how the adhesive of the prior art (FIG. 4 - adhesive on the edges) and*

Art Unit: 1772

*of the invention of the Kaye Patent (FIG. 6 -adhesive on the comers) differ in terms of the location of the adhesive. The sheets are shown in expanded form because the location of the adhesive could not be illustrated when the sheets are in their normal stacked position for use in the dispenser. The Kaye Patent makes clear that this is the intention or purpose of showing the stack of sheets in expanded form, and there is no reason to believe that one in the art viewing these figures in the context of the Kaye Patent would believe that the sheets could function as a toy. See~ Col. 4 lines 20-36 for the discussion of FIGs. 4 and 6 within the Kaye Patent. These are not found to be persuasive because applicant has failed to show that the stack of figures 4 and 6 of Kaye Patent would not provide for entertainment and/or amusement of its user, specially when is said accordion-like form. It is noted that if the stack of sheet of the claimed invention is used as a toy, then the stack of sheet of Kaye, having the same structure, would obviously be used a toy.*

*In response to applicant's argument that the Examiner also argues that forming of the semi-circular arcuate shape as required in claim 70 would have been an obvious design choice modification of the shape. Again, this is a purely conclusory hindsight assessment. The stack of sheets in Kaye are intended to lie fiat within a dispenser. There is no suggestion that they would be used as a toy and further no suggestion that the sheets would be expanded outside of the dispenser to result in any shape, much less an arcuate shape, applicant is directed hereinabove for response to the **hindsight argument**. As for the change in shape of*

Art Unit: 1772

Kaye, applicant has failed to show that the stack of sheet shown in figure-2 would not provide for the recreational entertainment if its shape is changed to a semi-circular.

*Applicant argues that the Examiner further argues that the higher peel strengths required by claims 63-68 would have been an obvious optimization through routine experimentation in order to hold the sheets together in a stack. This is based upon the incorrect premise that Kaye teaches or suggests use of a higher peel strength. There is no basis for that assertion, instead, Kaye specifically indicates that a "low tack repositionable adhesive" be utilized. (See column two, lines 66-67.) The Kaye Patent actually teaches away from utilizing a high-strength peel adhesion strength. The only purpose in using the high strength peel adhesion strength is in order to keep the sheets together when being used as a toy, the lower tack is needed for use in the dispenser. There is no motivation to optimize the peel strength because there is no motivation in Kaye to use the stack of sheets as a toy. This is not deemed to be convincing because, as explained in the last Office Action, the higher peel strength would enable the sheets to be held together in a stack form. To further support the position, applicant is directed to figures 4 and 6 of Kaye, wherein the adhesive holds the sheets together, even in the expanded form. Further, the adhesive of Kaye may be a "low tack repositionable adhesive", but it still provides for tack when the sheets are pulled and the particular claimed peel would have been obvious optimization to facilitating peelability while holding the successive sheets in a stack.*

Art Unit: 1772

Regarding applicant's argument that *as to claims 48-53, the Examiner relies upon the James Patent to show the various positions in which the stack of sheets may be placed during play. However, this presumes that the Kaye Patent suggests the use of the sheets as a toy. As discussed above, that is not the case. Given that Kaye does not suggest the use of the sheets as a toy, there is no motivation to combine Kaye with James*, applicant should note that as explained hereinabove and in the last Office Action, the stack of flexible sheets of Kaye is taken to be a recreational toy. Further, James clearly shows as to a toy being used by the steps s claimed in claims 48-53. Since, both the Kaye stack and the James product are toys, the motivation to combine the two is explained in the last Office Action, paragraph-7 because the movement of the palm would provide for entertainment to the user.

Applicant argues that *a prima facie case of obviousness had not been made as to the subject claims. There is nothing in either the Kaye Patent or the James Patent - either alone or in combination -that would teach or suggest using a stack of flexible sheets as a recreational toy. Applicant respectfully submits that when motivated to provide a toy for amusement to the user, one skilled in the art would not be motivated to look to office products, such as repositionable adhesive notes as disclosed in the Kaye Patent. That is, "the combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness."* In *re Oetiker*, 997 F.2d 1443, 1445 (Fed. Cir. 1992). This in not found to be convincing

Art Unit: 1772

because for the alleged **non-analogous sources**, applicant is informed that the determination that a reference is from a non-analogous art is two fold. First, we decide if the reference is within the filed of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor is involved. In this case, the James' patent is not within the field of applicant's endeavor as it does not teach a stack of flexible sheets. However, for the second factor, it is reasonably pertinent to the particular problem in that the teaching of moving the palm of one's hand would provide for the spreading step. Hence, a prima facie case of obviousness has been made.

Thus, in the absence of any evidence to the contrary, it remains the examiner's position that the claimed invention is obvious over the prior art of record discussed hereinabove.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.




Art Unit: 1772

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Nasser Ahmad  
Primary Examiner  
Art Unit 1772  
12/25/06

N. Ahmad.  
December 25, 2006.